

Reply to Office Action
S/N 10/687,528

Remarks

Claims 1-24 are pending in the application. Claims 1, 2, 4-8, 10, 12, 15 and 18-22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,180,201 to **Hauber**. Claims 3, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Hauber** in view of U.S. Pat. No. 2,427,909 to **Howell**. Claims 9, 11, 13, 14, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Hauber** in view of U.S. Pat. No. 2,473,065 to **Miller**. Claims 1, 12 and 20 are amended, and claims 16 and 18 are canceled. The Applicant respectfully traverses the rejections of Claims 1-15, 17 and 19-24 as discussed below.

I. Claims 1, 2, 4-8, 10, 12, 15 and 19-22 Are Not Anticipated by Hauber

Claims 1, 2, 4-8, 10, 12, 15 and 18-22 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,180,201 to **Hauber**. Claim 18 has been canceled, and claims 1, 12, and 20 have been amended. Claims 1, 2, 4-8, 10, 12, 15 and 19-22 each recite a spindle and an inside and an outside locking mechanism (or an inside and an outside lock) on the respective inside and outside ends of the spindle. Each of these claims also requires that the pairs of inside and outside locking mechanisms (or inside and outside locks) are configured to permit the spindle to be both selectively locked against rotation and selectively unlocked to permit rotation from either the inside or the outside of the lock. The specification describes such operability of the lock at page 8, line 21 to page 9, line 14.

Hauber does not disclose a lock as claimed. **Hauber** states that the latch can be "locked by the outside handle 18," (Col. 4, lines 29-30), and that the latch "can be opened by rotation of the inside handle 46, provided the nut 38 is pushed out of locked engagement with the bushing reduced end portion shoulder 34." **Hauber** does not describe a device, however, wherein the shaft (14) can be selectively locked against rotation by an inside lock or inside locking mechanism such that the shaft 14 cannot be rotated by the outside handle (18). Nor does **Hauber** describe a device wherein the outside handle can be unlocked from the inside end of the shaft (14). Indeed, in the device of **Hauber**, the shaft (14) can only be positively locked and unlocked from the outside.

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Therefore, **Hauber** does not disclose every limitation recited in any one of claims 1, 2, 4-8, 10, 12, 15 and 19-22, and the rejection of these claims under 35 U.S.C. 102(b) should be withdrawn.

**II. The Office Action Has Not Made Out a Prima Facie
Case of Obviousness as to Claims 1-11 and 16-24**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). *See* MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See Id.* Indeed, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. *See* MPEP 2143.01. Second, there must be a reasonable expectation of success. *See* MPEP 2143. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *See Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

A. Claims 3 and 17 are Patentable Over Hauber in View of Howell

Claims 3, 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Hauber** in view of **Howell**. Claim 16 is cancelled. The Office action states, "Howell teaches a key cylinder 22 on an outside handle 20," and it "would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a lock cylinder with the key lock on the outer handle of Hauber, in view of the teaching of Howell...." (p. 3) The Applicant respectfully traverses this rejection.

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Like the claims discussed above, claims 3 and 17 both require a spindle and an inside and an outside locking mechanism (or an inside and an outside lock) on the respective inside and outside ends of the spindle. Both of these claims also require that the pairs of inside and outside locking mechanisms (or inside and outside locks) are configured to permit the spindle to be both selectively locked against rotation and selectively unlocked to permit rotation from either the inside or the outside of the lock. As discussed above, **Hauber** does not describe a lock wherein the shaft (14) can be selectively locked against rotation by an inside lock (or inside locking mechanism) such that the shaft 14 cannot be rotated by the outside handle (18). Nor does **Hauber** describe a device wherein the outside handle can be unlocked from the inside end of the shaft (14). Indeed, in the device of **Hauber**, the shaft (14) can only be positively locked and unlocked from the outside. **Howell** similarly describes a lock wherein the shaft (26) can only be positively locked and unlocked by an outside locking mechanism (22). As explained in Applicant's specification, such systems "cannot be locked or unlocked from the inside of a garage door...." (page 3, lines 9-11)

Therefore, the references do not teach or suggest all of the claim limitations. Accordingly, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 3 and 17 under 35 U.S.C. 103(a) should be withdrawn.

B. Claims 9, 11, 13, 14, 23 and 24 are Patentable over Hauber in View of Miller

Claims 9, 11, 13, 14, 23 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Hauber** in view of **Miller**. The Office action states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an inner escutcheon for the inner handle and yoke of **Hauber** (201) in view of **Miller** (065)." The Applicant respectfully traverses this rejection.

Claims 9, 11, 13, 14, 23 and 24 each recite a garage door locking system that includes inner and outer locking mechanisms on the respective inside and outside ends of the spindle that are configured to permit the spindle to be both selectively locked against rotation and selectively

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unlocked to permit rotation from either the inside or the outside. As discussed immediately above, **Hauber** does not describe such a garage door locking system. **Miller** also fails to disclose such a locking system. Therefore, the cited references do not disclose all of the claim limitations, and at least for this reason, the rejection should be withdrawn.

In addition, **Miller** does not disclose or suggest an inside escutcheon as required by each of the rejected claims. A person of ordinary skill in the art at the time of the invention would understand that an "escutcheon" is a protective or ornamental plate or flange. As described in the specification, the inside escutcheon covers the functional inside portions of the lock, and helps to provide a "finished and elegant appearance to the interior of a door." (page 8, lines 6-9) **Miller** simply does not disclose or suggest an inner escutcheon as recited in the subject claims. The Office Action states that **Miller** teaches an inside escutcheon 11, 17. The base (11) and central portion (17) do not protect or cover any exposed operable inside portions of the lock described in **Miller**. To the contrary, the base (11) and central portion (17) of **Miller** underlie and are substantially hidden by the operable inside portions of the lock. Accordingly, the cited references do not teach or suggest all of the claim limitations, and the rejection should be withdrawn.

Therefore, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 9, 11, 13, 14, 23 and 24 under 35 U.S.C. 103(a) should be withdrawn.

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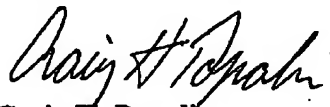
Conclusion

Applicant believes this case is now in condition for the immediate allowance of Claims 1-15, 17 and 19-24, and such action is respectfully requested. If any issue remains unresolved, however, Applicant's attorney welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,

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